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Docket No. TOL-100  
Serial No. 09/997,492Remarks

Claims 45-50 were previously pending in the subject application. By this amendment, the applicant has amended claim 45. Support for the amendments can be found throughout the subject specification including, for example, at page 6, line 26 through page 7, line 9. No new subject matter has been added by these amendments. Accordingly, upon entry of this amendment, claims 45-50 will be before the Examiner for consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. These amendments should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 45-49 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Merrifield (U.S. Patent No. 316,288). The applicant respectfully traverses this grounds for rejection because the Merrifield reference does not describe or even suggest the unique and effective hotel communication device of the current invention.

The subject specification advantageously provides methods for hotel guests to communicate instructions to housekeeping staff. These methods are particularly useful in that direct communication between guest and staff is circumvented and the instructions, as provided by the invention, will not be misplaced or lost. To ensure direct communication of instructions from guest to staff, the subject invention provides a communication device having an indicator that is adjacent to an indicator window, which is adjacent to an instructional window that displays various commands. With such a communication device, there is no need for the guest to write instructions on a card for display to the staff. The guest need merely slide the indicator to the desired command and instruction, which will be clearly communicated to hotel staff.

Merrifield does not teach nor suggest the currently claimed method. Rather, Merrifield makes reference to use of a hotel register device that provides various slots in which cards are placed, wherein information about a room or guest must be written on the cards by hotel staff. Blocks are placed over the cards and in the slots, wherein the position of the blocks over the cards

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indicates room vacancy or guest information (see claim; col. 1, line 51 through col. 2, line 81; and Figure 1). Merrifield fails to describe the steps of (a) providing a device having an indicator, an indicator window, and an instructional window, wherein the indicator is adjacent to the indicator window, and the indicator window is adjacent to the instructional window; (b) hotel guest selection of commands via manipulation of the indicator; or (c) hotel staff review of guest selection and performance of the command. Thus, the messages displayed and the actions resulting from the Merrifield device are very different from the displayed instructions and commands, as well as the actions elicited, by the device of the current invention.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, Merrifield does not contain a suggestion of the applicant's unique communication device. It is only the applicant's disclosure that provides such a teaching, and the applicant's disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Sponnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a § 103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art . . . ." *In re Dow Chemical Co.*, *supra* at 1531. In the Merrifield reference cited in support of the § 103 rejection, one finds neither. Thus, the applicant submits that Merrifield reference does not suggest the claimed invention of the subject invention. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. § 103(a).

Claim 50 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Merrifield in view of Bianco *et al.* (U.S. Patent No. 5,948,498).

The applicant respectfully traverses the rejection of claim 50 over Merrifield in view of Bianco *et al.* and submits that the references are uncombinable. As expressed by the Federal Circuit, “[u]nder section 103, teachings of references can be combined only if there is some suggestion or inventive to do so.” *ACS Hospital Sys., Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).

Merrifield does not suggest a need for a hotel register that is mounted on a wall. Because the register device of Merrifield discloses a specific purpose, there is no suggestion to look further for mounting the register on a wall.

Furthermore, even if there was some motivation to combine these references, the combination does not result in the methods and device of the subject invention. The message board of Bianco *et al.* teaches a board upon which either permanent or temporary record units are placed. There is no description or even suggestion by Bianco *et al.* to place on the board an indicator in an indicator slot, an indicator window, or an instructional window. Thus, the applicant submits that the combination of Merrifield and Bianco *et al.* does not teach the claimed invention. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. § 103(a).

In view of the foregoing remarks and the amendments set forth above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

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The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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